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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,947	09/29/2000	Mitsuaki Oshima	2000-1329	7026

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EXAMINER

LE, AMANDA T

ART UNIT

PAPER NUMBER

2634

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,947

Applicant(s)

OSHIMA ET AL.

Examiner

Amanda T Le

Art Unit

2634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 September 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 13-18 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 13-18 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. 08/240,521.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,4,6,7.

4) Interview Summary (PTO-413) Paper No(s). _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

Drawings

1. Although Applicants have requested to transfer the drawings from the parent application, similar requests have been made in all the other co-pending applications. The drawings will be transferred only to the reissue application serial no. 09/244,037. Formal drawings will be required for this Application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 13, 14, 16, 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claimed limitations of "an allocator operable to allocate code points along a uniaxial modulation coordinate system, and a filter, having a plurality of coefficients which are a series of impulse responses defined by plotting time base responses to the VSB modulation signal...along the uniaxial modulation coordination system" is not described expressively in the specification. The support for the claimed limitations in the specification (col. 48, lines 31-44, and 31-44, col. 52, lines 56-65, and Figs. 61, 62, 159), as indicated by the Applicants, simply discloses "a modulator" and "a VSB filter".

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 13, 14, 16, 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,600,672 in view of Glenn.

The patented claim discloses all the claimed limitations, except for "the first data stream has data for demodulation including synchronization data allocated at predetermined equal intervals". Glenn discloses a system wherein "code generating circuitry" (Fig. 1, element 220) generates a plurality of "code signals", to be transmitted with a first signal, including synchronization information of the second transmitted signal (see Abstract, col. 4, lines 13-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings to the patented claim and Glenn, collectively, to implement a system as claimed. Transmission of "synchronization information" enhances the demodulation process at the receiver.

4. Claims 13-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-18 of copending

Application No. 09/666,012, 09/667,525, 09/669,916, 09/668,068, 09/672,946, 09/672,948 in view of Glenn.

The co-pending claim discloses all the claimed limitations, except for "the first data stream has data for demodulation including synchronization data allocated at predetermined equal intervals". Glenn discloses a system wherein "code generating circuitry" (Fig. 1, element 220) generates a plurality of "code signals", to be transmitted with a first signal, including synchronization information of the second transmitted signal (see Abstract, col. 4, lines 13-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings to the co-pending claim and Glenn, collectively, to implement a system as claimed. Transmission of "synchronization information" enhances the demodulation process at the receiver. Further, omission of any means or step whose function is not needed for a particular design would have been obvious to one of ordinary skill in the art at the time of the invention.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al in view of Glenn.

Chung et al discloses all the claimed limitations (see Fig. 2), except for "the first data stream has data for demodulation including synchronization data allocated at predetermined equal intervals". Glenn discloses a receiver (Fig. 3) of a system wherein "code generating circuitry" (Fig. 1, element 220) generates a plurality of "code signals", to be transmitted with a first signal, including synchronization information of the second transmitted signal (see Abstract, col. 4, lines 13-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings to the co-pending claim and Glenn, collectively, to implement a system as claimed. Transmission of "synchronization information" enhances the demodulation process at the receiver.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Amanda Le** whose telephone number is **(703)305-4769**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Stephen Chin**, can be reached at **(703)305-4714**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Amanda Le
AMANDA T. LE
PRIMARY EXAMINER